

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Applicant's alleged Admitted Prior Art ("APA") and rejected claims 20-49 under 35 U.S.C. § 103(a) as being unpatentable over APA in view of U.S. Patent No. 5,504,502 to Arita et al. ("Arita").

By this Amendment, Applicant has amended claims 19, 21, 23-26, 33-35, 37, 43, 44, 46, 47, and 49 and cancelled claims 22, 27-32, 36, 39-42, 45, and 48 without prejudice or disclaimer of their subject matter. Claims 19-21, 23-26, 33-35, 37, 38, 43, 44, 46, 47, and 49 remain pending and under current examination.

**I. Rejection of claim 19 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the Examiner's rejection of claim 19 under 35 U.S.C. § 103(a) as being unpatentable over APA. No *prima facie* case of obviousness has been established.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

A *prima facie* case of obviousness has not been established, for at least the reason that APA does not teach or suggest each and every element of Applicant's independent claim 19. In particular, APA does not teach or suggest "a ring-like magnet . . . [that] is internally and externally magnetized in the direction of its radius of said ring-like magnet," as recited in amended claim 19 (emphasis added). For at least this reason, independent claim 19 is allowable over APA.

Figure 1 of the specification, on which the Examiner relies, discloses "a block diagram showing a magnetic detector circuit of a conventional magnetic detection type pointing device." Specification, page 1, lines 14-15. A "detecting section 1 includes four magnetic sensors" that "are placed symmetrically two by two on the X and Y axes." Specification, page 1, lines 15-21. A magnet is placed near the center of the four magnetic sensors symmetrically disposed on the X and Y axes. See Specification, page 1, lines 15-21. However, nothing in Figure 1 or the description of the detector circuit shown in the Figure discloses "a ring-like magnet . . . [that] is internally and externally magnetized in the direction of its radius of said ring-like magnet," as recited in claim 19 (emphasis added).

Figure 13 of the specification, also relied on by the Examiner, represents a configuration of a conventional pointing device. See Specification, page 23, lines 16-17. As shown in Figure 13, "magnet 72 is magnetized in the z direction" and is allowed to move in the both the x and y direction. See Specification, page 23, lines 17-19. Figure 13 also shows magnetic sensors 71 that detect the magnetic flux density in the z direction. See Specification, page 23, lines 21-27. However, Figure 13 and the descriptions of figure 13 at page 23-24 of the specification fail to describe "a ring-like

magnet . . . [that] is internally and externally magnetized in the direction of its radius of said ring-like magnet," as recited in claim 19 (emphasis added).

Indeed in the Office Action, the Examiner's admits that "AAPA doesn't explicitly teach a ring-like magnet." Instead the Examiner asserts that "it is obvious for one ordinary skill in the art . . . [to] supply either a rectangular, circular or ring magnet that is movably supported in parallel to a plane." Office Action, page 2. This is improper. The "[f]act that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. § 2112(IV) (emphasis added). Thus, "[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id (emphasis added).

Here, the Examiner has not provided any evidence that makes clear that the claimed method including "a ring-like magnet" is necessarily present in APA to satisfy all the elements of independent claim 19. Instead, Figures 1 and 13 illustrate a solid magnet. For at least these reasons, independent claim 19 is allowable over APA.

## **II. Rejection of claims 20-49 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the Examiner's rejection of claims 20-49 under 35 U.S.C. § 103(a) as being unpatentable over APA in view of Arita. Claims 22, 27-32, 36, 39-42, 45, and 48 have been cancelled, therefore, the rejection of these claims is moot. A *prima facie* case of obviousness has not been established.

Claims 20, 21, 23-26, 33-35, 37, 38, 43, 44, 46, 47, and 49 depend from claim 19 and require all of the elements recited in claim 19. As discussed above, APA fails to teach or suggest “a ring-like magnet . . . [that] is internally and externally magnetized in the direction of its radius of said ring-like magnet,” as recited in claim 19, and required by claims 20, 21, 23-26, 33-35, 37, 38, 43, 44, 46, 47, and 49 (emphasis added). Arita fails to cure the deficiencies of APA.

Applicant notes that the Examiner does not rely on Arita to describe “a ring like magnet” (Office Action, page 2). To the extent the Examiner now relies on Figures 25 and 27 of Arita, Applicant submits that the magnet described in Arita fails to teach or suggest “a ring-like magnet . . . [that] is internally and externally magnetized in the direction of its radius of said ring-like magnet,” as recited in claim 19, and required by claims 20, 21, 23-26, 33-35, 37, 38, 43, 44, 46, 47, and 49 (emphasis added). Thus, Arita, even if combinable with APA, fail to cure the noted deficiencies of APA.

Further, Arita fails to teach or suggest that “a plurality of magnetic sensors for detecting magnetic flux density produced by said ring-like magnet in a direction parallel to the plane are placed outside or inside said ring-like magnet” where the “magnetic sensors are disposed symmetrically from each other to said ring-like magnet,” as recited in amended claim 19, and required by claims 20, 21, 23-26, 33-35, 37, 38, 43, 44, 46, 47, and 49 (emphasis added). Instead, Arita discloses a solid cylindrical magnet that is magnetized on the upper and lower sides (thickness of solid cylindrical magnet) in the direction as shown Figure 9. This teaching in Arita does not constitute “a plurality of magnetic sensors for detecting magnetic flux density produced by said ring-like magnet in a direction parallel to the plane are placed outside or inside said ring-like magnet”

where the “magnetic sensors are disposed symmetrically from each other to said ring-like magnet,” as recited in amended claim 19, and required by claims 20, 21, 23-26, 33-35, 37, 38, 43, 44, 46, 47, and 49 (emphasis added).

For at least the reason that the cited references, whether taken alone or in combination, fail to teach or suggest each and every element of independent claim 19, which is required by claims 20, 21, 23-26, 33-35, 37, 38, 43, 44, 46, 47, and 49, a *prima facie* case of obviousness cannot be established with respect to claims 20, 21, 23-26, 33-35, 37, 38, 43, 44, 46, 47, and 49. Claims 20, 21, 23-26, 33-35, 37, 38, 43, 44, 46, 47, and 49 should therefore be allowable. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claim 20, 21, 23-26, 33-35, 37, 38, 43, 44, 46, 47, and 49 under 35 U.S.C. § 103(a).

**III. Dependent claim 21**

Regarding the rejection to dependent claim 21, Arita does not teach or suggest, “a printed circuit board on which a resin layer is provided.” Arita discloses a pointing control device including a slider 10, a housing 13, and a printed circuit board 17. See Arita, Figures 1 and 2 and Col. 4, lines 37-62. Moreover, slider 10 includes an elastic member 11 and a dome-shaped member 12. The Examiner apparently alleges that the slider 10 which includes an elastic member 11 and a dome-shaped member 12 correspond to the claimed “resin layer.” Office Action, page 6. Figure 2, which is an “exploded perspective view” of Figure 1, shows that the slider 10 which includes an elastic member 11 and a dome-shaped member 12 is mounted on the housing 13 **instead of on** the printed circuit board as claimed in claim 19. Thus, Arita does not teach or suggest a pointing device that includes an “a printed circuit board on which a

resin layer is provided," as recited in claim 32 (emphasis added). Thus, claim 21 is allowable for this additional reason.

**IV. Dependent claim 26**

Regarding the rejection to claim 26, the Examiner points to Figures 8A and 9A of Arita and alleges that "Arita discloses a ring-like magnet that has at least one of its internal wall and external wall magnetized in a multipolar manner." Office Action, page 5. The descriptions of Figures 8A and 9A of Arita disclose a "magnet . . . which is magnetized in the vertical direction" and "magnetic reluctance patterns 28-1-28-4 on a substrate 29 [where] each two opposing patterns are connected in series." See Arita, Col. 6, lines 5-14. However, there is no mention in Arita of "a ring-like magnet" having "its internal wall and external wall magnetized in a multipolar manner," as recited in claim 26 (emphasis added). If fact, these features are completely absent in Arita. Therefore, in addition to the reasons discussed above, claim 26 is further allowable over the applied references.

**CONCLUSION**


In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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